

### **REMARKS**

This communication responds to the Office Action mailed on November 3, 2006. Dependent claim 15 has been canceled to remove duplicative recitation of pre-existing language in independent claim 14. Dependent claims 18 and 19 have been amended to conform to the pre-existing language in independent claim 14, and not for reasons related to patentability. No claims are added. As a result, claims 1-14 and 16-25 are now pending in this Application.

#### **§101 Rejection of the Claims**

Claims 14-19 were rejected under 35 U.S.C. § 101 as being non-statutory. The Applicant respectfully traverses this rejection because the rejection is not in accordance with the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* promulgated by the United States Patent Office, and therefore does not establish a *prima facie* case of non-statutory claims.

Independent claim 14 recites “a machine-readable medium storing a behavioral level description ...including information to cause a simulator to model behavior of the RFID circuit ...” Thus, the claimed behavioral level description, perhaps compatible with a VHDL language format (as recited in claim 16), is used to direct simulators with respect to modeling the behavior of the described device. Therefore, contrary to the assertion by the Office, the behavioral level description is explicitly claimed as “capable of causing functional changes in a computer.” See Office Action, mail date 101706, pg. 2.

For example, the VHDL language has many different types of instructions, including procedure calls, conditions, trigger events, etc., being derived from ADA, a high-level programming language originally developed by the United States Department of Defense. Further information regarding behavioral descriptions, such as a hardware description language, may be obtained by consulting the *IEEE Standard VHDL Language Reference Manual*, Draft IEEE P1076/D3.0, June 20, 2006 (Revision of IEEE Std 1076-2002), The Institute of Electrical and Electronics Engineers, Inc., 2006.

As noted in the Guidelines for examination, “**If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a *useful, tangible and***

**concrete result.** In determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is ‘useful, tangible and concrete.’” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter, the “Guidelines”), pg. 20, October 2005. (emphasis added)

With respect to the Applicant’s claims 14 and 16-19, it is respectfully noted that a behavioral model stored in a machine-readable medium is **useful**, i.e. “(i) specific, (ii) substantial and (iii) credible ...” [*Id.* at pg. 20] (e.g., providing a behavioral model in a machine-readable medium is useful for simulating the operation of an RFID circuit, and “[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a ‘specific and substantial utility’) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.” M.P.E.P. § 2107.I).

Providing a behavioral model in a machine-readable medium is also **tangible**, being a mechanism for the efficient transfer of information to a computer when conducting a simulation. Finally, providing the model in a machine-readable medium is also **concrete**, since simulation results arising therefrom are substantially repeatable. Therefore, claims 14-19 constitute patentable subject matter according to the specific statements found in the USPTO Guidelines, and the Applicant respectfully requests that the Office reconsider and withdraw the rejection of these claims under 35 U.S.C. § 101.

#### Allowable Subject Matter

The Applicant notes with appreciation that claims 1-13 and 20-25 have been allowed.

#### CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant’s attorney at 210-308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHRISTOPHER J. DIORIO ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
210-308-5677

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By Mark V. Muller  
Mark V. Muller  
Reg. No. 37,509

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of December 2006.

/Dawn R. Shaw/

Dawn R. Shaw

Name

Signature